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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,489	03/02/2004	Yasuhiro Koyanagi	170A 3545	1873

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EXAMINER

RONESL VICKY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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03/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/791,489

Applicant(s)

KOYANAGI, YASUHIRO

Examiner

Vickey Ronesi

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/2007 has been entered.
2. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 12/11/2007.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 112

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 4, the term "liquid" with respect to zirconium oxide and polyvinyl acetate resin suggests that zirconium oxide and polyvinyl acetate resin are 100% zirconium oxide and polyvinyl acetate resin, respectively. In the interest of compact prosecution, the examiner has read "liquid" as being "emulsion" as supported by the specification. It is

suggested that “liquid” be replaced with “emulsion” when referring to zirconium oxide or polyvinyl acetate resin.

With respect to claims 2 and 3, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quemin (US 2005/0129639).

Quemin discloses a makeup composition comprising 0.5-25 wt % pigment such as zirconium oxide (paragraphs 0108 and 0175); 0.5-40 wt % of an oil phase such as liquid paraffin (paragraphs 0090, 0100); and 0.01-5 wt % of a nonionic thickener such as a vinyl acetate copolymer (paragraph 0190 and 0201). These percentages provide for a ratio that overlaps with the presently claimed ratio of 1 : 4 : 1.

With respect to claims 1 and 2, while Quemin does not exemplify a composition comprising zirconium oxide, liquid paraffin, and vinyl acetate resin, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such as an example is not controlling. Rather, all disclosures “including unpreferred embodiments” must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972). Therefore, it would have been obvious to one of ordinary skill in the art to utilize a composition comprising these ingredients given that Quemin teaches each one and thereby arrive at a composition which has the presently claimed X-ray analysis composition.

With respect to claim 3, these presently claimed elements are known impurities and as such are considered to be obviously present in the composition taught by Quemin, there being no

showing or suggestion in the instant application that these elements contribute any advantage to the present invention. Rather, they are coincidentally present and cannot serve to patentably distinguish the instant claims from the prior art.

Response to Arguments

6. Applicant's arguments filed 12/11/2007 have been fully considered but they are not persuasive. Specifically, applicant argues that the zirconium oxide of Quemin is not in an emulsion or a liquid state.

In response, it is noted that the instant claims requiring that the zirconium oxide emulsion be mixed with the liquid paraffin and polyvinyl acetate emulsion are product-by-process claims. While Quemin does not teach mixing zirconium oxide into an emulsion before being added to the liquid paraffin and the emulsion of polyvinyl acetate resin, this does not change the fact that the final product of the mixture is the same. In other words, dispersing zirconium oxide in water before mixing with liquid paraffin and the emulsion of polyvinyl acetate resin does not provide for a different product since the final product also has water. Case law holds that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, Quemin teaches that the solid fillers such as pigments are dispersed in the aqueous phase with surfactants (paragraph 00179), thus forming an emulsion in the final product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/28/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/
Supervisory Patent Examiner, Art Unit 1796